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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,369	03/06/2002	Samantha H. Stetson	006560.P014	8236
26263 7590 12/22/2008 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				
EXAMINER				
ALVAREZ, RAQUEL				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
12/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/092,369

Applicant(s)

STETSON ET AL.

Examiner

Raquel Alvarez

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 11-14, 16-19, 21-22, 24-26, 31, 33, 35, 37, 45-46, 48-51, 54-56, 58, 60, 72, 74, 78-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1,8,11-14,16-19,21,22,24-26,31,33,35,37,45,46,48-51,54-56,58,60,72,74 and 78-82.

DETAILED ACTION

1. This office action is in response to communication filed on 10/15/2008.
2. Claims 1, 8, 11-14, 16-19, 21-22, 24-26, 31, 33, 35, 37, 45-46, 48-51, 54-56, 58, 60, 72, 74, 78-82 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8, 11-14, 16-19, 21-22, 24-26, 31, 33, 35, 37, 45-46, 49-51-56, 58, 60, 72, 74 and 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (6,128,663 hereinafter Thomas) in view of Official Notice.

With respect to claims 1, 8, 11-14, 16, 18-19, 31, 33, 35, 45, 49-50, 54-56, 58, 60, 72, 74, 78-81 Thomas teaches displaying a message in conjunction with an advertisement on a World Wide Web Page (Abstract). Determining an advertisement to be displayed on a World Wide Web page (i.e. page requested)(col. 4, lines 53-65); determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said advertisement (i.e. banner ad)(col. 4, lines 53-65 and col. 8, lines 64-66); determining targeting criteria associated with said message (i.e. banner ad related to the requested page); receiving a request to serve said World Wide Web page and serving said World Wide Web page (col. 4, lines 53-65 and col. 8, lines

53 to col. 9, lines 1-9); serving said advertisement for display on said World Wide Web page, tailoring said message based on said targeting criteria and serving said tailored message for display on said World Wide Web page (col. 4, lines 53-65 and col. 8, lines 53-65).

With respect to receiving personal information from a user about the user. Thomas teaches receiving personal information about the user (col. 2, lines 1-24). Thomas is silent as to the information being received from the user. Official Notice is taken that it is old and well known to receive personal information from the user such as user's name, age and gender when a user fills out an application and the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving personal information from the user in order to allow the user control of his or her information.

With respect to said tailored message being separate from the advertisement. Thomas teaches the user receiving a banner advertisement (tailored message) the banner advertisement (tailored message) being separate from the requested page (advertisement). Thomas is silent as to the location of the message in proportion to the advertisement. Nevertheless, official Notice is taken that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad.

With respect to claims 21-22, Thomas further teaches tailoring said message based on external information (i.e. receiving demographic information from other sites)(col. 2, lines 64 to col. 3, lines 1-24).

Claim 17 further recites serving a second message when said tailored message is no longer to be displayed. Official Notice is taken that it is old and well known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included serving a second message when said tailored message is no longer to be displayed in order to allow the customer to always receive or be exposed to a message.

Claims 24-25, 37, 51 further recite that said tailored message is to be displayed proximal to the advertisement. Thomas is silent as to the location of the message in proportion to the advertisement. Nevertheless, official Notice is taken that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad.

Claim 26 further recites changing a display attribute within said tailored message. Official Notice is taken that changing display attribute within a message such as changing display color or image will bring the user's attention to the message.

Claims 46, 82 further recite serving or determining a default message if said targeting criteria has not been met. Official Notice is taken that it is old and well known to serve default messages when said targeting criteria hasn't been met. For example, default messages or general messages are displayed to the customer when the customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

Response to Arguments

5. Applicant argues that Thomas doesn't describe serving a greeting that is both related to the advertisement and personal information about the user. The Examiner disagrees with Applicant because Thomas teaches the requested page being equivalent to the Applicant's advertisement, the claims do not exclude the advertisement from being a requested page. Applicant's claimed tailored message being the banner ad of Thomas which contains a greeting about the user and information about the requested page. Therefore, contrary to Applicant's arguments, Thomas teaches the banner ad or tailored message being related to the page requested and based on the user's demographic information. In Thomas, the banner ad is equivalent to the tailored message in the claims and the requested page is equivalent to the advertisement being claimed.

6. Applicant argues that Thomas doesn't teach selecting one of the messages based on personal information and targeting criteria. The Examiner disagrees with Applicant because Thomas teaches on col. 4, lines 60-65, "particular advertising banner that is chosen to be transmitted with the requested page is determined not, randomly, but in accordance with the demographic identifier....selecting appropriate variant of the requested page" As can be seen by the cited portion of Thomas above, Thomas teaches the message (banner) being based on demographic identifier and appropriate variant so therefore the message or banner are not chosen randomly but customized based on the demographic and user interests (col. 4, lines 1-14).

7. Applicant argues that Thomas doesn't teach a message that is displayed separate from the advertisement, but is on the same page as the advertisement. The Examiner disagrees with Applicant because Thomas teaches the banner ad being separate from the requested page but being transmitted along with the banner ad. As can be seen by Figure 11, a user searches a category such as "music" and the system determines the listing to present to the user based on that criteria. The system in addition to presenting the user with the requested information or advertisement, it also displays an additional message (banner) on the page related to "music", the banner being on the same page but separate from the requested information.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). Applicant argues that Thomas doesn't teach the message being proximal to the advertisement. The Examiner wants to point out that the Examiner had taken official notice that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad. In addition, after careful review Figure 11, shows the requested information (advertisement) being proximal to the banner ad.

Conclusion

8. This is an RCE and all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
12/12/2008